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| 10/534,021 | 12/29/2005 | Jacques Soux | 0518-1148 | 1365 |
| <div>465 7590 08/17/2009 YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314</div> | | | <div>EXAMINER BARTOSIK, ANTHONY N</div> | |
| | | | <div>ART UNIT 3635</div> | <div>PAPER NUMBER</div> |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,021

Applicant(s)

SOUX, JACQUES

Examiner

ANTHONY N. BARTOSIK

Art Unit

3635

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 & 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-33 and 35-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/29/2005 & 07/16/2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is a Non-Final Rejection sent in response to Applicant's RCE of July 16, 2009.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a block being free of the pair of flanges as set forth in claim 36 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: the specification as originally filed does not contain a language describing an "upper bearing surface" and a "lower supported surface" and found in the amended claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The rejection previous rejection under 35 USC § 112 is hereby removed.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. **Claims 22-33 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rolle (US 3,343,328) in view of Strey et al. (DE 19835241).**

6. In Re claim 22, Figures 2-9 and 18-20 of Rolle disclose an upper face (*top of 40*) and a lower face (*bottom of 40*) and two opposite ends (*sides of 40*);

a splined tongue and groove joint (56 – Fig. 3 & Col. 5, Lines 14-16, *i.e. wooden or metal plugs*) at each of the two ends, parallel to the wall facings and perpendicular to the upper and lower faces, for a symmetrical assembly at the two ends of the block (40);

at each splined tongue and groove joint, a group of two countersunk holes (54 - Fig. 2 - Col. 4, Lines 72 through Col. 5, Lines 1-5, *see also* Figs. 18-20 *reference numeral* 98) perpendicular to the upper face, passing through the block (40) up to the lower face and located on an axis that is parallel to the flanges and between the latter, in the same longitudinal axis as the splined tongue and groove joints (56) and

means for screwing or nailing (*nails* - Col. 5, Lines 1-2) inserted into each of the countersunk holes at a depth equal to at least one third of the thickness of the block.

Rolle discloses a flange and groove connection between vertically adjacent blocks, however, the flange of Rolle discloses a single flange and groove as opposed to a pair of flanges and grooves.

Figure 1 of Strey teaches that it is well known to include a pair of flanges (22) on the upper face and a pair of grooves on the lower face (3) for the assembly of the block by tongue and groove joint, a diameter of each groove is greater than a diameter of the flange in the same vertical axis;

the upper face comprising an upper bearing surface (*area between flanges*) located within and delimited by adjacent interior edges of the pair of flanges;

the lower face comprising a lower supported surface (*area between grooves*) located within and delimited by adjacent interior edges of the pair of grooves.

Modifying Rolle to include a pair of flanges and a pair of grooves instead of the single flange and groove connection would have been obvious to one skilled in the art at the time of the invention as a simple substitution of one known element for another to

obtain a predictable result. Additionally, the above substitution would have been obvious as the two connections are known equivalents in the art.

7. In Re claim 32, Figures 2-9 and 18-20 of Rolle disclose an upper face (*top of 40*) and a lower face (*bottom of 40*) and two opposite ends (*sides of 40*);

a splined tongue and groove joint (56 – Fig. 3 & Col. 5, Lines 14-16, *i.e. wooden or metal plugs*) at each of the two ends, parallel to the wall facings and perpendicular to the upper and lower faces, for a symmetrical assembly at the two ends of the block (40);

holes (54 - Fig. 2 – Col. 4, Lines 72 *through* Col. 5, Lines 1-5, *see also* Figs. 18-20 *reference numeral* 98) located at each splined tongue and groove joint, each of the holes being a countersunk hole perpendicular to the upper face, passing through the block up to the lower face and located on an axis that is parallel to the flange and between the latter, in the same longitudinal axis as the splined tongue and groove joint; where in the holes are located symmetrically at the two ends of the block.

Rolle discloses a flange and groove connection between vertically adjacent blocks, however, the flange of Rolle discloses a single flange and groove as opposed to a pair of flanges and grooves.

Figure 1 of Strey teaches that it is well known to include a pair of flanges (22) on the upper face and a pair of grooves on the lower face (3) for the assembly of the block by tongue and groove joint, a longitudinal axis of the flanges on the upper face and a longitudinal axis of the grooves on the lower face facing each other two by two on the same vertical axis.

Modifying Rolle to include a pair of flanges and a pair of grooves instead of the single flange and groove connection would have been obvious to one skilled in the art at the time of the invention as a simple substitution of one known element for another to obtain a predictable result. Additionally, the above substitution would have been obvious as the two connections are known equivalents in the art.

Rolle does disclose the countersunk holes, but not a group of two as claimed. Including two pairs of countersunk holes at the splined tongue and groove joint would be obvious as a design choice well within the skill of one having ordinary skill in the art in order to construct a stronger connection. Furthermore the duplication of parts performing the same function and purpose would be obvious absent new or unexpected results. MPEP 2144.04(VI.)(B). Here, including additional holes for fasteners would be known to lead to the predictable result of the connection between the blocks being stronger.

Regarding dimensions of the claim as they relate to the holes, Applicant has failed to establish a criticality for the explicitly claimed dimensions. In *Gardner v. TEC Systems, Inc.*, the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984) (citing MPEP 2144.04(IV)).

Accordingly, from the reasoning as set forth above, the combination renders the claim obvious.

8. In Re claims 23, 24, 25, 27-31, 33, 35, 37, and 38, the combination of Rolle and Strey et al. discloses the claimed invention but do not disclose the specific dimensions or shape of the block. Regarding the specifically claimed dimensions, Applicant has failed to establish a criticality for the explicitly claimed dimensions. In *Gardner v. TEC Systems, Inc.*, the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984) (citing MPEP 2144.04(IV)).

Regarding the claimed shapes, the combination discloses the claimed invention except for the particular shapes. The Court in, *In re Dailey* held that changes in shape is a matter of design choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular shape of the claimed container was significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (citing MPEP 2144.04(IV)). Here the shape of the block, flanges, and grooves present no significant or unexpected results and would therefore be obvious as such a change would clearly be within the skill in the art.

From the above reasoning, it would have been an obvious design choice to dimension Strey et al. as specified in the claims, as no new or unpredictable results are reached by the claimed invention.

9. In Re claim 26, Figure 1 of Strey teaches a beveled edge (52).

10. In Re claim 36, Figures 1-10 of Rolle disclose together with another said block, wherein said upper face (*top of 40*) comprises of a region containing said pair of flanges and a remaining end region defined by a portion of the upper face to be covered by joining another block at a right angle at said end region, said end region being free of said pair of flanges (Fig. 6 *at 78*).

Response to Arguments

11. Applicant's arguments filed 7/16/2009 have been fully considered but they are not persuasive.

12. **Applicant argues** that the countersunk holes of Rolle are not for insertion of screwing or nailing means and refers to reference numeral 180 in Rolle. Applicant has erred in their reading of both the Final Rejection of 3/17/2009 and the Rolle reference. As clearly set forth in paragraph 7 of the rejection the countersunk holes found to disclose the claimed limitations are holes **54** and not 180. Also Fig. 2 – Col. 4, Lines 72 *through* Col. 5, Lines 1-5, *see also* Figs. 18-20 of Rolle describe the holes and there

purpose for securing the block. Accordingly, Rolle does meet the claimed limitations directed to the countersunk holes.

13. **Applicant argues** that the dimensions found in claims 23 and 24 provide for the optimal values for the strength of the assembly. The first item worth noting regarding Applicant's remarks regarding the assembly is that the claims are solely directed to a single block and not an assembled wall. This argument is unpersuasive as the MPEP is clear as to the effect of recited dimensions within a claim as it relates to the prior art. MPEP 2144.04(IV)(A.) makes clear that when the only difference between the prior art and the claims are the relative dimensions, those claims are not patentable when the device would not perform differently. Here, the combination of Rolle and Strey yield a block that's only difference between the claimed invention is the recitation of dimensions. As both the combination and the present invention are blocks they would perform the same and are not therefore distinguished by dimensions. Furthermore, sizing a block as claimed would be well within the ordinary skill of one in the art in order to find the desired characterizes.

14. **Applicant argues** that the semicircle shape of the flanges and grooves differs from the cited art. The Examiner acknowledges the difference between the flanges and grooves of the combination and those of the present invention. These differences, however, do not render the claims patentable. Changing the shape of the flanges and grooves to be semicircle would be obvious to one having ordinary skill in the art as the

semicircle shape is a known shape that does not present a configuration that yields new or unpredictable results. Applicant's remarks regarding the shape do not rise to the level of evidence needed to establish that the shape is of patentable significance.

15. Applicant's other arguments have been considered but are moot in view of the new ground(s) of rejection under the combination of only Rolle and Strey.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTHONY N. BARTOSIK whose telephone number is (571)270-3112. The examiner can normally be reached on M-F 7:30-5:00; E.D.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635

Anthony Bartosik
Examiner
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